UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/700,364	11/03/2003	Joseph J. Harding	RANPP0349USA	5961

23908 7590 05/25/2006

RENNER OTTO BOISSELLE & SKLAR, LLP
1621 EUCLID AVENUE
NINETEENTH FLOOR
CLEVELAND, OH 44115

EXAMINER	
HARMON, CHRISTOPHER R	

ART UNIT	PAPER NUMBER
3721	

DATE MAILED: 05/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/700,364
Filing Date: November 03, 2003
Appellant(s): HARDING, JOSEPH J.

Christopher Jacobs
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 3/9/06 appealing from the Office action mailed 8/1/05. It is noted that the appeal brief erroneously has headings directed towards application no. 09/150,819 on pages 2+. These headings are disregarded. Furthermore, section V (Background) of the appeal brief (pages 2-4) is immaterial and ignored.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

This appeal involves claims 12-15.

Claims 1-10 are allowed as noted in the Advisory Action of 5/11/06.

(4) Status of Amendments After Final

The amendment after final rejection filed on 3/9/06 has been entered.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner. The rejection of claims 1-10 as being unpatentable under 35 USC 103(a) over Harding and Reynolds et al.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,871,429	Harding	2-1999
5,719,678	Reynolds et al.	2-1998
3,819,918	Hale	6-1974

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 12 and 14 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Harding et al. (US 5,871,429).

Harding et al show a dunnage dispenser which dispenses a controlled amount of dunnage material, a void-measuring apparatus 302 and a logic 48 connected to the void measuring device to vary the amount of dunnage material to fill the containers accordingly. The logic device corresponds to an input device in the form of a lookup table to determine the selection of void-fill density. (co 18 lines 24+).

Claims 13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harding et al. (US 5,871,429) in view of Hale (US 3,819,918) or Reynolds et al. (US 5,719,678).

Harding et al substantially show the claimed subject matter including having a void-fill system that includes a dunnage dispenser, a container scanner 302 that measures the void volume of a container. Harding et al show the use of optical and ultrasonic sensors which transfer information to logic device processor 48 which instructs the machine to produce the required number and lengths of dunnage pads to

fill the container (col 18 lines 10-41). Harding et al disclose that the probe may scan the container in one or more areas to determine the amount of pad needed to fill the container (col 18 lines 34+) using logic device 48. Harding et al do not show a height, width and contour sensor as claimed as well as a conveyor for conveying the container in a scan area. Both Hale and Reynolds et al show the use of conveying means that have height, width, length and/or volume sensors to sense the volume of an object. Hale discloses that the operation creates a dependable measuring device which accurately measures, the length, width, and height of the cartons as the cartons move on a conveyor system (col 2 lines 41+) while Reynolds et al disclose that the system is an automated system of determining volumes without requiring openings in a conveyor and to obtain other information in addition to the volume. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide Harding et al with the sensing/control means on a conveyor as taught by Hale or Reynolds et al to determine other characteristics other than volume as well as creating a dependable measuring device. The contour sensor is read on the volume sensors for the secondary references. Both references show the sensors being elevated. Reynolds et al show sensing means 120 on an upright as well as sensing means 200 on an upright and sensing means 122 being elevated wherein it must inherently be mounted on some beam structure. Regarding the actual type of sensing means being claimed, it is well known in the art to use infrared distance sensors, as well as optic laser sensors.

The logic device corresponds with a lookup table to automatically determine the amount of dunnage to make (col 18 lines 15+). Since there is a lookup table which

corresponds to a logic controller 48, there are inherently going to be multiple void-fill densities in the look-up table to make a desired or varied amount of dunnage material. The lookup table reads on an input device as claimed.

(10) Response to Argument

Regarding claims 12-15, the dunnage dispenser of Harding et al. varies the amount of dunnage per measured volume of void in response to a void measuring apparatus/probe 302. The limitation of "an input device...which enables selection of a void-fill density from a plurality of void-fill densities" is anticipated by the control mechanism with an input table. The void fill density of a container with an item will vary upon the empty volume of the container thus is dependent upon the container to be filled. During patent examination, the claims are given the broadest reasonable interpretation consistent with the specification. See In re Morris, 127 F.3d 1048, 44 USPQ2d 1023 (Fed. Cir. 1997). See MPEP § 904.1.

Appellant is arguing that there are multiple dunnage products with varying densities and the dunnage dispenser is controlled by selection of a desired density. The claims do not recite such structural limitations. It is noted that while features of an apparatus may be recited either structurally or functionally, claims directed towards an apparatus must be distinguished from the prior art in terms of structure rather than function. See *In re Schreiber*, 128 F.3d 1473-78, 44 USPQ2d 1429-32 (Fed.Cir. 1997) and *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed.Cir. 1990). However the disclosure of Harding et al. is fully capable of

performing the void fill density selection as claimed. Note that the input table corresponds to a value "per measured volume of void".

The arguments directed towards "a means for selecting" are unpersuasive because this limitation is not recited in the claims nor are the limitations of the claims treated under 35 USC 112(6).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Chris Harmon, Patent Examiner

Rinaldi I. Rada
Supervisory Patent Examiner
Group 3700

Conferees:

Louis Huynh, Primary Examiner

John Sipos, Expert Examiner